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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,559	07/21/2000	Hiromichi Ishida	A235	4599

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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC  
8321 OLD COURTHOUSE ROAD  
SUITE 200  
VIENNA, VA 22182-3817

EXAMINER

DANIEL JR, WILLIE J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/621,559

Applicant(s)

Ishida

Examiner

Rafael Perez-Gutierrez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 and 36-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-35 and 40-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Action is in response to Applicant's amendment on September 30, 2004. **Claims 1-55** are still pending in the present application. **This Action is made NON-FINAL.**

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-8, 13-35, and 40-55** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Boltz (U.S. Patent # 6,131,024)** in view of **Norihisa et al. (JP 05-284255)**.

Consider **claims 1, 17, 28, and 44**, Boltz clearly shows and discloses a method of making a call, a storage medium, and an information terminal 300 (figure 3) having a function of making

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a call, comprising:

a communicator (inherent) making communication with a calling or called party (column 1 lines 36-40);

a memory storing at least one an exception code (column 2 lines 52-61 and column 3 lines 41-53); and

a main control unit (inherent), said main control unit determining an item to be monitored, judging whether said item meets with a predetermined condition for prohibiting making a call, judging whether a code of a calling or called party is coincident with said exception code, and prohibiting making a call, if said predetermined condition satisfied, and if said code of a calling or called party is not coincident with said exception code (abstract, figure 2, column 2 line 52 - column 3 line 4, column 3 line 41 - column 4 line 9, and column 4 line 29 - column 5 line 4).

However, Boltz does not specifically disclose that the main control unit is in the information terminal (mobile communication device).

In the same field of endeavor, Norihisa et al. clearly show and disclose as information terminal (figure 1) that comprises controlling sections 7-11 for determining an item to be monitored, judging whether said item meets with a predetermined condition for prohibiting making a call, judging whether a code of a calling or called party is coincident with said exception code, and prohibiting making a call, if said predetermined condition satisfied, and if said code of a calling or called party is not coincident with said exception code (abstract, figure 1, and paragraphs 0005-0010).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the controlling section disclosed by Norihisa et al. in the terminal taught by Boltz for the purpose of controlling communications at the subscriber equipment level.

Consider **claims 2 and 29**, and **as applied to claims 1 and 28 above**, Boltz, as modified by Norihisa et al., further disclose wherein said main control unit allows a desired exception code to be stored in said memory (column 2 lines 52-61).

Consider **claims 3, 4, 18, 30, 31, and 45**, and **as applied to claims 1, 17, and 28 above**, Boltz, as modified by Norihisa et al., also disclose wherein said main control unit judges whether a clear condition, designated by a controller, is satisfied or not, and resets said item, if said clear condition is satisfied (column 3 lines 41-67 and column 4 line 59 - column 6 line 4).

Consider **claims 5, 13, 14, 19, 20, 24, 25, 32, 40, 41, 46, 47, 51, and 52**, and **as applied to claims 1, 3, 4, 17, 28, and 45 above**, Boltz, as modified by Norihisa et al., further disclose wherein said main control unit determines a fee index corresponding to a communication fee, as said item, judges whether said fee index is over a predetermined upper limit of a fee index, and judges that said predetermined condition for prohibiting making a call is satisfied, if said fee index is over said predetermined upper limit of a fee index (column 3 lines 41-67).

Consider **claims 6-8, 15, 16, 21-23, 26, 27, 33-35, 42, 43, 48-50, 53, and 54**, and **as applied to claims 3, 5, 14, 18, 19, 25, 30, 32, 41, 45, 52, and 55 above**, Boltz, as modified by Norihisa et al., also disclose wherein said main control unit calculates said fee index based on an index signal transmitted during communication, wherein said clear condition is that the present

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date reaches a predetermined date, and wherein said clear condition is that a predetermined data is transmitted during communication (column 2 lines 52-61, column 3 lines 41-67, and column 4 line 59 - column 6 line 4).

***Response to Arguments***

4. Applicant's arguments with respect to **claims 1-8, 13-35, and 40-55** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-


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7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

  
Rafael Perez-Gutierrez  
R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**  
**PRIMARY EXAMINER**

March 18, 2005